



# UNITED STATES PATENT AND TRADEMARK OFFICE

*CL*  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,342	04/14/2004	Nobert Hofgen	HUBR-1260-US	5382
24972	7590	08/03/2006	EXAMINER	
FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198				MORRIS, PATRICIA L
ART UNIT		PAPER NUMBER		
		1625		

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/824,342	HOFGEN ET AL.
	Examiner Patricia L. Morris	Art Unit 1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 May 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3,5,6,13,16,17 and 20 is/are pending in the application.
  - 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 5 and 20 is/are rejected.
- 7) Claim(s) 2,3,6,16 and 17 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

Claims 1-3, 5, 6, 16, 17 and 20 are under consideration in this application.

Claim 13 is now withdrawn from consideration as being drawn to nonelected subject matter. 37 CFR 1.142(b).

### *Election/Restrictions*

Claim 13 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Applicants now for the first time asserts that claim 13 includes any and all unknown additional active ingredients. There was never an original claim in the application drawn to compositions containing additional active ingredients. Claim 13 had been searched to the extent readable on the elected compounds plus an additional inert carrier. The compounds in the claims do not require an additional active ingredient for their use. Applicants have failed to amend claim 13 to overcome the 35 U.S.C. rejection and merely insist that Claim 13 requires an additional ingredient. Hence, claim 13 is drawn to a patentably distinct invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 13 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The requirement is still deemed sound and proper and is therefore made FINAL.

Again, this application has been examined in regard to the elected compound wherein R<sup>1</sup>, R<sup>4</sup> and R<sup>5</sup> represent non-heterocyclic groups and R<sup>2</sup>, R<sup>3</sup> as set forth in claim 1, exclusively. It is suggested that the nonelected compounds be deleted.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The plural 's' on "salts" makes claim 5 read on mixtures rather than specific compounds. Moreover, the expression "and physiologically ....thereof" is improper Markush language because it is not written in alternative language. It is suggested that the "and" be changed to --OR--.

Claim 20 lacks antecedent basis and is now broader than claim 1. Claim 1 recites that R<sup>4</sup> and R<sup>5</sup> can only be F, Cl, Br or I.

The claims measure the invention. United Carbon Co. V. Binney & Smith Co., 55 USPQ 381 at 384, col. 1, end of 1st paragraph, Supreme Court of the United States (1942).

The C.C.P.A. in 1978 held "that invention is the subject matter defined by the claims submitted by the applicant. We have consistently held that no applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim": In re Priest, 199 USPQ 11, at 15.

***Terminal Disclaimer***

The terminal disclaimer filed on May 17, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Ser. No. 10/825,862 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Allowable Subject Matter***

Claim 1 is objected to as containing nonelected subject matter. The objection may be overcome by limiting the claim to the subject matter indicated as being examinable, *supra*. A claim so limited would appear allowable.

Claims 2, 3, 6, 16 and 17 presented in independent form or made dependent on an allowable claim, would appear allowable, otherwise it is objected to as being dependent on a non allowed claim.

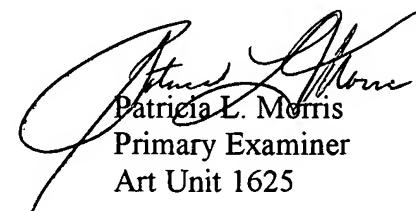
Claims 5 and 20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688. The examiner can normally be reached on Mondays through Fridays.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patricia L. Morris  
Primary Examiner  
Art Unit 1625

plm  
July 31, 2006